

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY S. WALKER,
DANIEL E. TEDESCO, STEPHEN C. TULLEY
and WEN YAN LIN

Application 09/540,034

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 8, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the file reveals that on April 5, 2004, an Appeal Brief and extension of time were filed which requested that the fees be charged to Deposit Account 50-0271. The Patent and Trademark Office records reflect that these fees have not been charged. Correction is required.

In addition, the Final Rejection mailed October 10, 2003 noted that claims 1-48, 50-56 and 59-66 were rejected under 35 U.S.C. § 101. Numerous rejections under 35 U.S.C. § 103 were also made. Appellants reiterated these grounds of rejection under the caption "ISSUES" appearing on pages 11 and 12 of the Appeal Brief filed April 5, 2004. In his Answer mailed August 27, 2004, the examiner states that "[t]he appellant's [sic] statement of the issues in the brief is correct" (page 2). At the bottom of page 3 under the heading "Grounds of Rejection," the examiner states that "[t]he rejection of the claims as appearing in the Final Office Action is reproduced as an appendix to this answer." It should be noted that the Appendix only reproduces the § 103 rejections, not the § 101 rejection. Clarification as to the status of the § 101 rejection is required.

Lastly, an Information Disclosure Statement (IDS) was filed June 27, 2003. It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Accordingly, it is

ORDERED that the application is returned to the examiner:

1. to charge the \$165 Appeal Brief fee and the \$55 one month extension fee to Deposit Account 50-0271 as requested by the transmittal letter appended to the Appeal Brief filed April 5, 2004;

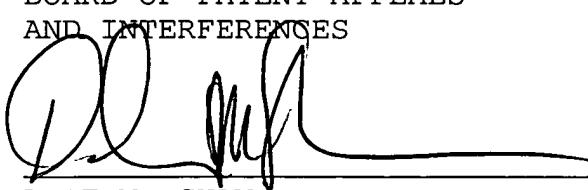
2. to clarify the status regarding the § 101 rejection of claims 1-48, 50-56 and 59-66;

3. to consider the IDS filed June 27, 2003, and notify appellants regarding the Primary Examiner's decision;

4. for written communication to appellants regarding the action taken; and

5. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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